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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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INSKEEP INTELLECTUAL PROPERTY GROUP, INC
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EXAMINER

NILAND, PATRICK DENNIS

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 03/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/764,762

Applicant(s)

MORAVEC ET AL.

Examiner

Patrick D. Niland

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/04</u> . | 6) <input type="checkbox"/> Other: ____. |

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1. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. The instant claim 1 recites weight percentages of photochromic compounds and stabilizers. It is unclear what these percentages are based on, e.g. the entire composition, the resin, or some other basis.

B. The instant claim 2 does not end with a period. It is therefore unclear what else is required of the claim.

See MPEP 608.01(m) [R-3] Form of Claims

The claim or claims must commence on a separate physical sheet or electronic page and should appear after the detailed description of the invention. Any sheet including a claim or portion of a claim may not contain any other parts of the application or other material.

While there is no set statutory form for claims, the present Office practice is to insist that each claim must be the object of a sentence starting with "I (or we) claim," "The invention claimed is" (or the equivalent). If, at the time of allowance, the quoted terminology is not present, it is inserted by the Office of Patent Publication. Each claim begins with a capital letter and ends with a period.

C. The Markush groups of claim 2 are improper. The first Markush group has the "and" before the penultimate member of the group. Since the claim is limited to two amines, it is unclear if claim 2 actually requires 3 amines due to the claim recitation of "and" prior to the penultimately listed amine. The second Markush group does not recite "and" or "or". It is therefore unclear what else may be in the list. See MPEP 2173.05(h).

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D. It is unclear what is meant by –methyl(1,2,2,6,6-pentamethyl-4-piperidinyl)sebacate. It is unclear if it is intended to be attached to the prior sebacate and if so how. Since only two HALS are allowed by the claim, it is not seen that it can be a third independent moiety.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. Application Pub. No. 2004/0207809 Blackburn et al. and US Pat. No. 5770115 Misura which is cited in Blackburn.

Blackburn discloses photochromic coatings of polyurethane (section [0023] and [0048]-[0052]), the instantly claimed amount of photochromic compound (section [0060]), the instantly claimed thickness (section [0063]), and the instantly claimed stabilizer system having the instantly claimed amounts of stabilizers (section [0088]) which references the stabilizer systems

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of Misura. Based on the ratio of photochromic compound to stabilizer of Misura (abstract) and the amount of photochromic compound to resin of Blackburn, the instantly claimed amount of stabilizer is encompassed by Blackburn. Misura discloses combinations of phenolic antioxidant and mixtures of two HALS for stabilizing polyurethanes at column 1, lines 5-20; column 2, lines 13-16 and 30-31; column 3, lines 17-33; column 4, lines 15-67 of which lines 35-44 encompasses the instantly claimed improvement in light fatigue; column 5, lines 1-15; column 7, lines 57-67; column 8, lines 15-17 and 59-67; column 9, lines 40-43 and 62; column 10, lines 48-55; column 11, lines 1-46 which encompasses the HALS and phenol of the instant claim 2; column 12, lines 13-16; column 13, lines 1-67 in which the change in b^* appears to be that of the instant claims; columns 15-16, tables 3-6 which exemplify mixtures of HALS and in which the change in b^* appears to be that of the instant claims.

5. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. Application Pub. No. 2004/0207809 Blackburn et al. and US Pat. No. 5770115 Misura which is cited in Blackburn in view of US Pat. No. 6113813 Goudjil and US Pat. No. 4962013 Tateoka et al..

Blackburn discloses photochromic coatings of polyurethane (section [0023] and [0048]-[0052]), the instantly claimed amount of photochromic compound (section [0060]), the instantly claimed thickness (section [0063]), and the instantly claimed stabilizer system having the instantly claimed amounts of stabilizers (section [0088]) which references the stabilizer systems of Misura. Based on the ratio of photochromic compound to stabilizer of Misura (abstract) and the amount of photochromic compound to resin of Blackburn, the instantly claimed amount of stabilizer is encompassed by Blackburn. Misura discloses combinations of phenolic antioxidant

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and mixtures of two HALS for stabilizing polyurethanes at column 1, lines 5-20; column 2, lines 13-16 and 30-31; column 3, lines 17-33; column 4, lines 15-67 of which lines 35-44 encompasses the instantly claimed improvement in light fatigue; column 5, lines 1-15; column 7, lines 57-67; column 8, lines 15-17 and 59-67; column 9, lines 40-43 and 62; column 10, lines 48-55; column 11, lines 1-46 which encompasses the HALS and phenol of the instant claim 2; column 12, lines 13-16; column 13, lines 1-67 in which the change in b^* appears to be that of the instant claims; columns 15-16, tables 3-6 which exemplify mixtures of HALS and in which the change in b^* appears to be that of the instant claims.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the stabilizer mixtures of Misura which fall within the scope of the instant claims in the coatings of Blackburn. Alternatively, it would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed coating thickness in the polyurethane based coatings of Misura containing the instantly claimed stabilizers because Blackburn states that the instantly claimed coating thicknesses are typical in the art (section [0063]) and Misura encompasses the other aspects of the instant claims as stated above.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the stabilizer mixtures of Goudjil, which fall within the scope of the HALS of the instant claim 3, in the films of Blackburn discussed above because the combinations of HALS and antioxidants encompassed therein are encompassed by Blackburn and would have been expected to give the combinations of benefits taught by Goudjil and Blackburn. See

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Goudjil, column 5, lines 16-45 and 66-67; column 6, lines 10-26; column 3, lines 59-62; column 4, lines 18-30; and the remainder of the document.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed antioxidant of claim 3 as the antioxidant of Blackburn because it is encompassed by the broad language of Blackburn and Tateoka shows it to be known for use as an antioxidant in similar photochromic films at column 21, structure D-27 and column 27, lines 20-37 and the remainder of the document and it would have been expected to contribute its antioxidant properties to the film of Blackburn.

6. Claims 1-2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pat. No. 6113813 Goudjil.

Goudjil discloses the instantly claimed films and laminates at the abstract; column 2, lines 60-67; column 3, lines 1-22 and 59-62; column 4, lines 1-30 and 58; column 5, lines 15-45, which encompasses the instantly claimed stabilizer mixtures, and 66-67 which encompasses the instantly claimed amount of photochromic compounds; column 6, lines 1-26; column 7, lines 50-58; column 8, lines 1-56, particularly line 2; and the remainder of the document. Since the patentee uses the instantly claimed stabilizer combinations, his films must necessarily and inherently possess the instantly claimed improvement in light fatigue and change in b*.

7. Claims 1-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pat. No. 6113813 Goudjil in view of US Pat. No. 4962013 Tateoka et al..

Goudjil discloses the instantly claimed films and laminates at the abstract; column 2, lines 60-67; column 3, lines 1-22 and 59-62; column 4, lines 1-30 and 58; column 5, lines 15-45, which encompasses the instantly claimed stabilizer mixtures, and 66-67 which encompasses the

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instantly claimed amount of photochromic compounds; column 6, lines 1-26; column 7, lines 50-58; column 8, lines 1-56, particularly line 2; and the remainder of the document. Since the patentee uses the instantly claimed stabilizer combinations, his films must necessarily and inherently possess the instantly claimed improvement in light fatigue and change in b*.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed combinations of ingredients encompassed by Goudjil in the films of Goudjil because they are disclosed by the patentee and would have been expected to give the properties disclosed by the patentee.

It would have been obvious to one of ordinary skill in the art at the time of the instant invention to use the instantly claimed antioxidant of claim 3 as the antioxidant of Goudjil because it is encompassed by the broad language of Goudjil and Tateoka shows it to be known for use as an antioxidant in similar photochromic films at column 21, structure D-27 and column 27, lines 20-37 and the remainder of the document and it would have been expected to contribute its antioxidant properties to the film of Goudjil.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Thursday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications

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may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Patrick D. Niland
Primary Examiner
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